UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,765	01/05/2004	Valerie de la Poterie	5725.0479-01	1698

22852 7590 11/30/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
ALSTRUM ACEVEDO, JAMES HENRY	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,765	DE LA POTERIE, VALERIE	
	Examiner	Art Unit	
	James H. Alstrum-Acevedo	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *1-39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/05/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-39 are pending.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The use of the trademarks LUVITOL® (pages 24 and 26), KRATON® (pages 24, 27, 35, 36, 39, 41, 43, 45, 46, and Table 1), VERSAGEL® (page 27), gelled PERMETHYL® (page 30), EXPANCEL® (page 30), POLYTRAP® (page 30), ORGASOL® (page 30), TEFLON® (page 30), and BENTONE® (Table 1) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8, 14, and 33-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 further limits claim 1 by requiring that the polymer particles "can form a film" (line 2 of said claim 8). The verb "can" implies a potential or capability of forming a film, however this is not a positive recitation, because it is unclear if this limitation is required or merely that the possibility of the particles forming a film is sufficient to meet the limitation of claim 8.

Claim 14 recites the term "higher" in reference to both fatty acids and fatty alcohols. It is noted that the Applicant lists examples of both "higher fatty alcohols" and "higher fatty acids" on page 17 of the specification, it is unclear how many carbon atoms are required to differentiate a "higher" alcohol or fatty acid from a "lower" fatty acid or alcohol and if the Applicant intends for the term "higher" to exclude hydrophobic macromolecular alcohols and carboxylic acids. Clarification is requested.

The remaining claims are rejected as being dependent upon a rejected claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Mougin et al. (WO 97/00662, published January 9, 1997) using U.S. Patent No. 5,945,095 as its English language equivalent.

Mougin discloses a (1) **cosmetic** composition comprising **fatty substances** and **pulverulent compounds** comprising a dispersion of surface-stabilized polymer particles in a liquid fatty substance; (2) a cast product comprising at least one wax, comprising a dispersion of crosslinked and surface-stabilized polymer particles in a cosmetically, dermatologically,

hygienically or pharmaceutically acceptable **liquid fatty substance**; and (3) a compact powder, comprising a fatty binder and pulverulent compounds, comprising a dispersion of surface-stabilized polymer particles in a cosmetically, dermatologically, pharmaceutically or hygienically acceptable liquid fatty substance (column 2, lines 63-67 and column 3, lines 1-5), wherein the stabilizing polymers are non-film formers (column 3, lines12-14). Cosmetic compositions applied to the skin or the lips as make-up or care product (lip bases, lipsticks or foundations) generally contain fatty substances (e.g. waxes, oils, **pigments** and/or fillers and, possibly, additives)(column 1, lines 12-16).

Mougin discloses that the film forming polymers may or may not be crosslinked and are vinyl or acrylic **radical copolymers** or **homopolymers** (e.g. **polymethyl methacrylate** or **polystyrene**) (column 4, lines 43-53).

Mougin discloses that the polymers used in her invention may be of any nature – **radical polymers, polycondensates, or polymers of natural origin** (column 4, lines 8-11).

Mougin discloses that the liquid fatty substance (i.e. the liquid fatty phase) may consist of any cosmetically or dermatologically acceptable oil, chosen from **carbon-based, hydrocarbon, fluoro and/or silicone oils of mineral, animal, plant or synthetic origin**, wherein specific examples are provided (column 4, lines 53-67 and column 5, lines 1-23).

Mougin discloses that the stabilizing polymer used during the polymerization **must be soluble or dispersible in the fatty substance** (column 7, lines 10-12).

Mougin discloses **sequential or grafted block copolymers** comprising at least one block resulting from the **polymerization of dienes**, and at least one block of a vinyl polymer, in

particular of "diblock" or "**triblock**" type (e.g. polystyrene/polyisoprene, etc) (column 7, lines 38-48).

Mougin discloses the limitations of the following claims of the instant application: 12 (column 8, lines 18-39), 16 (column 6, lines 56-59), 17 (column 7, lines 13-26), 18 (column 7, lines 38-48), 19 (column 8, lines 47-53), 20 (column 9, lines 29-34), 25 (column 5, lines 20-24), 26 (column 10, lines 29-33 and column 10, lines 50-52), 27 (column 2, lines 44-50 and column 10, lines 50-52), 28 and 29 (column 10, lines 50-52), 30-32 (column 6, lines 25-67), 33-39 (column 5, lines 2-21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6-14, 16, 19, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter (U.S. Patent No. 5,5898,195).

Potter teaches a proteinaceous **emulsion** and method for making a proteinaceous emulsion comprising a **lipophilic phase, an aqueous phase and a protein emulsifier**; which is capable of forming a thin film and has the capability of **carrying active ingredients** contained in either or both the aqueous phase and the lipophilic phase of the emulsion (abstract).

Potter teaches that **oils and/or oily substances are common constituents in topical skin applications**, **specifically cosmetic creams and lotions**. These oils and/or oily substances are desirable additions to such topical applications in that they tend to form a thin, fluid film, which retards the drying of the skin after evaporation of other volatile ingredients found in the cream or lotion (column 1, lines 44-50).

Potter teaches that virtually any lipophilic constituent, including oils or oily substances, can be readily emulsified with these proteinaceous materials, including **emollients**, **oil-based vitamins**, defoliants, **essential oils**, flavorants, sunscreen agents, insect repellents, pharmaceuticals and the like along with other active ingredients which are soluble or can be carried in the lipophilic phase (column 2, lines 20-28).

Potter teaches that the proteinaceous materials serve in a multiple capacity as **emulsifiers**, **co-emulsifiers**, **thickeners**, whiteners and **film-formers** (column 2, lines 38-42).

Potter teaches that the active ingredient may preferably comprise an active ingredient suitable for topical applications, and may preferably be a **pharmaceutical**, pesticide or **cosmetic agent** (column 2, lines 51-54).

It would have been obvious to a person of ordinary skill in the art at the time of the instant invention that Potter's compositions could be used in topical applications in lieu of the compositions of the instant application, because Potter's compositions comprise lipophilic

proteins, which function as thickeners and stabilizing agents (i.e. emulsifiers) and liquid fatty phases (e.g. oils). It would also have been apparent to a skilled artisan that proteins are polycondensate polyamide polymers and are therefor obvious over polyesteramides and polyacrylamides. A person of ordinary skill in the art also would have known that oils and oily substances are commonly used in cosmetic compositions and thus it would have been obvious to also include additional fatty substances in cosmetic compositions, such as waxes, gums, and pasty fatty substances of plant, mineral, synthetic or silicone origin, and mixtures thereof. A skilled artisan would have known that thickeners are used to modify viscosity and therefor the routine optimization of a composition's viscosity is well within the ability of said artisan. Potter teaches that his compositions may be used to carry a cosmetic active agent, therefor well known cosmetic forms, including foundation, blusher, eye shadow, lipstick, etc are obvious (see the table of contents in Jellinek, J. S. *Formulation and Function of Cosmetics*, Wiley-Interscience: New York, 1970.). The amount of a specific ingredient in a composition (e.g. rheological agent) is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention.

Conclusion

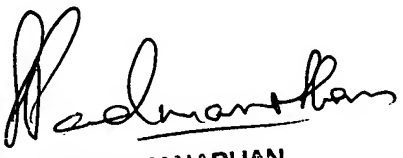
The specification is objected. Claims 1-39 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Alstrum-Acevedo, Ph.D.
Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER